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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,557	10/14/2003	Charles S. Taylor	GUID-005CON6	5455
89729	7590	06/17/2011		
Law Office of Alan W. Cannon 942 Mesa Oak Court Sunnyvale, CA 94086			EXAMINER SINGH, SUNIL K	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 06/17/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/684,557	Applicant(s) TAYLOR ET AL.	
	Examiner SUNIL K. SINGH	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 224-230 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 224-230 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/10/2011 has been entered.

Claim Objections

2. Claim 224 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim states that the contact member is continuously adjustable but that limitation is already stated in the independent claim (line 8).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3732

4. Claims 1,224,,226-228 and 230 rejected under 35 U.S.C. 102(e) as being anticipated by Boyd et al. (US 5,799,661).

Boyd discloses a device that includes: a shaft (239) having a proximal end portion and a distal end portion (Figs. 42-44); a contact member (231) attached to the distal end portion of the shaft (Figs. 42-44); the contact member comprising a flexible main body (238) having a contact surface and an elongated malleable member extending along a length of said flexible main body member (metal wire) (column 21, lines 25-45); wherein the malleable member is **capable** of being shaped to engage the surface of the beating heart; wherein the malleable member is **capable** of being continuously adjustably shapeable by manipulation thereof to a desired shape and wherein upon release of manipulation forces, said malleable member maintains said desired shape and maintains a contact surface in the desired shape (column 19, lines 60-65 disclose that the wire is made of titanium allow (also see column 21, lines 30-40) and such a material is malleable and capable of performing the intended function); wherein the shaft is **capable** of having sufficient strength to withstand a stabilizing force exerted on the heart via manipulation or fixation of said shaft to cause said contact member to exert a stabilizing force exerted on the heart via manipulation or fixation of said shaft to cause said contact member to exert a stabilizing force on the beating heart; wherein the contact member is substantially cylindrical (Fig. 44) and wherein the malleable member comprises a wire (column 21, lines 25-45).

5. Claims 225 and 229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd and further in view of Buckman, Jr. et al. (US 5,582,580).

Boyd discloses the invention substantially as claimed except for a device that includes a vacuum for introducing positive/negative fluid pressure to the contact member.

Buckman teaches a device that includes a means (vacuum)for introducing positive/negative fluid pressure to the contact member (82) and wherein the contact member (82) is malleable (Fig. 7) (column 9, line 28-column 10, line 63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Boyd to include a means for introducing pressure to the contact member, as taught by Buckman, in order to provide an alternate means of shaping the contact member that is allows the contact member to have a plurality of different shapes. Furthermore, such means are well known in the art.

Response to Arguments

6. Applicant's arguments filed 05/10/2011 have been fully considered but they are not persuasive. Applicant argues that Boyd does not disclose a malleable contact member performing the claimed function. However, the Examiner notes that the claims are directed to an apparatus. In an apparatus claim, the intended use does not have to be explicitly disclosed in the prior art but rather the structure of the device and that the device is capable of performing the intended function. It is the Examiner's position that since Boyd's contact member is made of a malleable material (titanium alloy), it will be capable of performing the intended function. The applicant has not provided any reason or support why the malleable member of Boyd is not capable of being continuously adjusted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIL K. SINGH whose telephone number is (571)272-3460. The examiner can normally be reached on Monday-Friday (Increased Flex Schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris L. Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

06/15/2011

/SUNIL K SINGH/
Examiner, Art Unit 3732